

REMARKS

Claims 1, 34, 37, 40 and 43-47 are pending and at issue. By the present communication no claims have been added, canceled, or amended.

Rejections under 35 U.S.C. §102

Applicants respectfully traverse the rejection of claims 1, 34, 37, 40, 43, 46 and 47 under 35 U.S.C. §102(e) as being allegedly anticipated by Barker et al. (U.S. Patent Number 6,369,201; hereinafter, "Barker"). The Advisory Action alleges that claimed subject matter has not been accorded the benefit of priority to U.S. Serial No. 09/124,180 (hereinafter, "the '180 application"). As such, the Action concludes that Barker is valid prior art under 35 U.S.C. §102(e).

The Action alleges that, "[n]othing applicant has pointed to shows contemplation of these smaller peptides as being part of the invention disclosed in the parent application." Applicants respectfully submit that the Action misapprehends the standard for claiming priority by alleging that the gist of the invention was not disclosed in the '180 application. However, distillation down to a gist or core is a superficial mode of analysis that disregards elements of the whole. (*Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986). In contrast,

[u]nder 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). (M.P.E.P. §201.11-IB).

Furthermore, M.P.E.P. §201.11 summarizes the relevant conditions for a later-filed application to receive the benefit of the filing date of a prior-filed application under 35 U.S.C. 120 as follows: (1) The prior-filed application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112; (2) The later-filed application must be copending with the prior-filed nonprovisional application; (3) The later-filed application must contain a reference to the prior-filed application in the first sentence(s) of

the specification or in an application data sheet; (4) The later-filed application must be filed by an inventor or inventors named in the prior-filed application; (5) If the later-filed application is a utility or plant application filed on or after November 29, 2000, the reference to the prior-filed application must be submitted within the time period set forth in 37 CFR 1.78(a). Applicants submit that the '180 application satisfies the conditions set forth under 35 U.S.C. 120 so as to entitle the claimed invention to the benefit of priority to July 28, 1998.

With regard to the first condition, Applicants submit that the '180 application satisfies the written description and enablement requirements of 35 U.S.C. 112 for the reasons set forth in the response filed on May 9, 2007.

With regard to the second condition, Applicants submit that an Advisory Action was mailed in connection with the '180 application on November 13, 2000, which is approximately three months after the actual filing date of the instant application. Accordingly, the instant application was copending with the '180 application.

With regard to the third condition, Applicants submit that the first sentence of the instant application as filed contains a reference to the '180 application.

With regard to the fourth condition, Applicants submit that the inventors identified in both the '180 application and the instant application are Se-Jin Lee and Alexandra C. McPherron.

With regard to the fifth condition, Applicants submit that reference to and a claim for priority to the '180 application were filed concurrently with the instant application.

Thus, based on the foregoing, Applicants respectfully submit that the claimed invention enjoys the benefit of priority of the '180 application, and the effective date for the instant amended claims is July 28, 1998. Because Barker et al. was filed on February 18, 1999, the reference is not available as prior art. Accordingly, withdrawal of the rejection of the claims 1, 34, 37, 40, 43, 46 and 47 under 35 U.S.C. § 102(e) is respectfully requested.

Conclusion

In view of the above remarks, it is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application.

The Commissioner is hereby authorized to charge \$930.00 as payment for the Petition for Three-Month Extension of Time fee (\$525.00) and Request for Continued Examination fee (\$405.00) to Deposit Account No. 07-1896. Additionally, the Commissioner is hereby authorized to charge any other fees that may be due in connection with the filing of this paper, or credit any overpayment to Deposit Account No. 07-1896, referencing the above-identified docket number.

Respectfully submitted,

Date: December 6, 2007



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